

## **REMARKS**

This Amendment and the following remarks are intended to fully respond to the Office Action dated October 17, 2006. In that Office Action claims 33, 35, 37, 39, 40, 43, 45, 46, 51-61, 63 and 64 were examined, and all claims were rejected. More specifically, claims 33, 35, 37, 39, 40, 52, 53-57, 59-61 and 64 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Beaton et al. (U.S.P.N. 6,037,937), and Eftekhari (U.S. Publ. No. 2002/0024505). Claims 43, 45 and 46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Beaton et al., Eftekhari, and Pisutha-Arnond (U.S.P.N. 5,745,116). Claims 51 and 63 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Beaton et al., Eftekhari, and Hoeksma (U.S.P.N. 6,271,835). Reconsideration of these rejections is respectfully requested in light of the above amendments and following remarks.

In this Response, claims 33, 35, 37, 39, 40, 51-53, 55-57, 59, 61, 63-65 remain pending in the application.

### **I. Summary of Examiner Interview**

The undersigned thanks Examiner Vu for the courtesy of a telephone conference on December 18, 2006, where issues relating to the two main prior art references (Beaton and Eftekhari) were discussed and various claim amendments were proposed. The above amendments to independent claims 33 and 55 represent the scope of the claim amendments discussed during the interview, and the Examiner indicated such amendments would likely overcome the pending rejections (pending further review and consultation with the Examiner's supervisor). Additionally, the prior art status of the Eftekhari reference was briefly discussed during the interview, and a detailed explanation regarding why the Eftekhari publication can no longer be considered as prior art to the present application is included below.

### **II. Claim Amendments**

Independent claim 33 has been amended to incorporate the subject matter of dependent claim 35 (i.e., a plurality of input elements and corresponding control images), and has further been amended to note that the input elements positioned on the housing are "arranged about a perimeter of the display." This limitation is described in the patent and does not constitute new

matter. For example, FIG. 3B of the present application illustrates four separate input elements (332, 334, 336 and 338), each of which are arranged about a perimeter of the display screen 312. Additionally, the term “proximate” within claim 33 has been replaced by the phrase “immediately adjacent” to clarify that each control image is displayed “immediately adjacent” a corresponding input element to “associate” the input element with the control image.

The above-described amendments to claim 33 are proposal believed to overcome the obviousness rejection in light of Beaton and Eftekhari (although Eftekhari no longer qualifies as prior art as noted below). In particular, page 9 of the Office action noted that “Beaton teaches positioning the control image in the background of the display proximate the input element (figs. 3A and 10A-10C; navigation control on keypad 330 is proximate the control image).” While Applicant respectfully disagrees that the keypad 330 in Beaton is located “proximate” to the background image in the display, the above amendments further remove the “proximate” language and further distinguish the Beaton reference. Additionally, the keypad 330 does not show or suggest a plurality of input elements “arranged about a perimeter of the display.” Furthermore, Applicant points out that the background images in Beaton are not controlled by the keypad 330, as alleged in the Office action, but rather by a touch screen display as shown in FIGS. 8 and 10A-C.

Thus, in light of the above amendments and remarks, claim 33 is now believed to be in condition for allowance. Independent claim 55 has been similarly amended and is also believed to be allowable for the reasons discussed above. Additionally, independent claim 43 has been cancelled along with the dependent claims depending from claim 43 (although claims 51-53 have been amended to depend from independent claim 33).

In addition to the above amendments to independent claims 33 and 55, numerous dependent claims have been amended or canceled. For example, dependent claim 35 has been amended to further recite that the plurality of input elements comprises a “first pair” of input positioned on opposite sides of the housing, while new claim 65 depends from claim 35 and recites a second pair of inputs (as shown in the exemplary embodiment of FIGS. 3A-C). Each of these dependent claims is believed to be allowable in conjunction with their corresponding independent claim, as described above.

**III. Recent Claim Amendments Clarify that Eftekhari Fails to Constitute “Prior Art”**

In each prior response, Applicant has argued that the cited Eftekhari publication (U.S. Publ. No. 2002/0024505) does not constitute prior art to the present application in light of the previously submitted Rule 131 declaration. In sum, because Applicant has sworn behind the filing date of the Eftekhari publication, and because the parent application is abandoned, Eftekhari can only be granted the effective priority date of the abandoned parent if Eftekhari includes **issued claims** that are fully supported by the disclosure of the abandoned parent application. See MPEP § 2136.03(IV) and the Wertheim decision cited therein.

Although the claims of the Eftekhari application were previously in a state of flux, a recent amendment to those claims has led to a Notice of Allowance being mailed by the Patent Office on November 14, 2006. The undersigned has reviewed both the pending Eftekhari application and the original (abandoned) parent application, and has further reviewed the recently amended claims that led to the Notice of Allowance. Attached hereto as Appendix A is a marked-up copy of the published Eftekhari application noting the relevant portions of the specification that were added by the continuation-in-part application (i.e., that were not found in the original, abandoned application). Additionally, Appendix B attached hereto includes a copy of the amendment and response (as well as the Notice of Allowance) which clearly demonstrates that each independent claim has been amended to recite a limitation added by the CIP application (as highlighted in Appendix A).

In light of this recent change in the status of the Eftekhari CIP application, it is now apparent that Eftekhari can **not** be granted the effective priority date of the abandoned parent application. Thus, due to the prior Rule 131 declaration pre-dating the filing date of the Eftekhari application (which application was filed only one week prior to the present application), Applicant respectfully points out that Eftekhari can no longer be cited against the present application. Thus, while the presently amended claims are believed to be allowable in light of the above amendments and remarks, the removal of the Eftekhari application as prior art provides a further basis for immediate allowance of the pending claims.

**Conclusion**

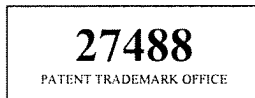
The pending claims 33, 35, 37, 39, 40, 51-53, 55-57, 59, 61 and 63-65 are believed to be in condition for allowance, and such action is respectfully requested. Furthermore, since the above amendments and remarks are believed to fully distinguish the applied references, any remaining arguments supporting the rejected claims are not acquiesced to because they are not addressed herein. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

It is believed that no fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

Respectfully submitted,

MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, Minnesota 55402-0903  
(303) 357-1634

Date: January 8, 2007



  
\_\_\_\_\_  
John B. Phillips  
Reg. No. 37,206